00862.023559. PATENT APPLICATION

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:	)	
	:	Examiner: J. Roberts
HIROSHI TOJO	)	
	:	Group Art Unit: 2482
Application No.: 10/829,437	)	
	:	Technology Center: 2400
Filed: April 22, 2004	)	
	:	Confirmation No. 8784
For: MOVING IMAGE PROCESSING METHOD AND APPARATUS	)	
	:	December 23, 2010

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY BRIEF

Sir:

This Reply Brief is submitted in support of Appellant's appeal from the final rejection of Claims 12 to 23 in the above-identified application, and in response to the Examiner's Answer dated October 28, 2010.

CERTIFICATE OF EFS-WEB TRANSMISSION
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/Michael K. O'Neill/ — December 23, 2010
Signature — Date of Signature

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I. STATUS OF CLAIMS

The Examiner's Answer did not object to the Status set out in Appellant's Brief On Appeal. For convenience, that Status is repeated here.

Cancelled:	Claims 1 to 11	
Pending:	Claims 12 to 23, of which only Claims 12 and 21 are independent	
Rejected:	Claims 12 to 23, under 35 U.S.C. § 103(a), as follows:	
	Claims 12 and 21:	over Japan 8-163488 (Matsushita '488), "Applicant Admitted Prior Art" (AAPA), and Official Notice
	Dependent Claims 13 to 17, 19, 20, 22 and 23:	over Matsushita '488, AAPA and Official Notice
	Dependent Claim 18:	over Matsushita '488, AAPA, Japan 5-147337 (published as JP 7-023322, hereafter "Matsushita '322") and Official Notice
Rejections Appealed:	Claims 12 to 23	

II. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

The Examiner's Answer did not object to the Grounds of Rejection as set out in Appellant's' Brief On Appeal. For convenience, those Grounds are repeated here.

1. Whether the rejection of Claims 12 and 21 under 35 U.S.C. § 103(a) over Japan 8-163488 (Matsushita '488), "Applicant Admitted Prior Art" (AAPA) and Official Notice should be reversed.

2. Whether the rejection of Claims 13 to 17, 19, 20, 22 and 23 under 35 U.S.C. § 103(a) over Matsushita '488, AAPA and Official Notice should be reversed.

3. Whether the rejection of Claim 18 under 35 U.S.C. § 103(a) over Matsushita '488, AAPA, Matsushita '322 and Official Notice should be reversed.

Page 3 of the Examiner's Answer appears to introduce a new reference into the rejection, but in fact it does not. Page 3 for the first time lists U.S. Publication No. 2004/0239769 (Tojo), and refers to it as "Applicant Admitted Prior Art" (AAPA). Tojo is simply a publication of the instant application. It is not known why the Examiner has substituted references to the published application, rather than maintaining reliance on the instant application, especially since this is contrary to the rules.

III. **ARGUMENT**

Insofar as Appellant is able to determine, pages 1 through 12 of the Examiner's Answer are identical to the Final Rejection. Accordingly, this section will address new material that commences on page 13 of the Examiner's Answer.

With regard to independent Claims 12 and 21, arguments 1 to 4 below respectively respond to sections I to IV in the Examiner's Answer.

A. Independent Claims 12 and 21

1. The Rejection Of Claims 12 And 21 Should Be Reversed Because The Office Action Is Contradictory On Its Face, Such That There Is a Clear Deficiency In The Prima Facie Case For Rejection.

Appellant resubmits that the Office Action is contradictory on its face, and that the rejection is deficient for at least this reason alone. As discussed below, the Examiner's Answer completely sidesteps this contradiction, and does not address it at all.

To reiterate, the Office Action concedes in one breath that a claimed feature is not shown in AAPA, and then asserts in another breath that it is. Specifically, page 9 of the Office Action concedes that Matsushita '488 and AAPA do not disclose hierarchizing a plurality of division information in the case that the plurality of division information is generated in correspondence with a plurality of item groups:

> "Matsushita (modified by AAPA) as [a] whole does not explicitly disclose wherein the plurality of division information is hierarchized and the division positions are added in a case that the plurality of division information is generated in the generation step in

correspondence with a plurality of item groups." Office Action, page 9.

Nevertheless, the Office Action relies on Official Notice for this feature. But in response to Appellant's traversal of Official Notice and in support of documentary evidence for this feature, the Office Action points right back to the same inadequate AAPA which the Office Action concedes does not disclose the feature in the first place:

> "As to Applicants argument to traverse the Office Action's assertion that disclose of hierarchizing a plurality of division information in the case that a plurality of division information is generated in correspondence with a plurality of item groups is well-known in the art. The Examiner respectfully disagrees...Since AAPA discloses to divide the image changing points into layers (gain, white balance, zoom and pan), and create a division result, it is clear to the Examiner that AAPA teaches to add the changing point layers to create the division result which reads upon the claimed limitation." Office Action, pages 4 and 5.

Thus, as explained in the Appeal Brief, the Office Action is contradictory on its face, such that there is a clear deficiency in the prima facie case in support of the rejection.

Meanwhile, the portion of the Examiner's Answer responding to Appellant's position is reproduced in its entirety below. As can be seen, the Examiner's Answer does not address, discuss, or even mention the contradiction in the Office Action:

> "The Examiner respectfully disagrees. The claimed feature is disclosed in the Applicants Admitted Prior Art, which was provided to show that it's common and well known in the art. In this case, Applicants Admitted Prior Art (AAPA), discloses in paragraph [0004] that Fig. 17 is a view for explaining the conventional moving

image dividing technique. (a) of Fig. 17 shows the changing points (Gain, White Balance, subject distance, Zoom, Pan) of the operation intervals and the states of the image sensing devices with respect to a single m moving image for respective items. (b) of the Fig. 17 shows the image dividing result using these Gain, White Balance, subject distance, Zoom and Pan items. As shown in Fig. 17, since division positions based on a plurality of different items are present together, the moving image is segmented into many intervals. The Examiner notes that a hierarchy is synonymous with positions. Since AAPA discloses that (a) of Fig. 17 shows the changing points (Gain, White Balance, subject distance, Zoom, Pan) of the operation intervals and the states of the image sensing devices with respect to a single moving image for respective items. (b) of the Fig. 17 shows the image dividing results using these Gain, White Balance, subject distance, Zoom, and Pan items. As shown in Fig. 17, since division positions based on a plurality of different items are present together, the moving image is segmented into many intervals, it is clear to the examiner that AAPA discloses the positions (hierarchy) for a plurality of division information (Gain, White Balance, subject distance, Zoom, and Pan for a plurality of items groups, which reads upon the claimed limitation." Examiner's Answer, pages 14 and 15.

Nowhere does the Examiner's Reply address the contradiction between the Office Action's concession on the failings of the AAPA to show a hierarchy, and the Office Action's reliance on the deficient AAPA, to show the hierarchy that is concededly not shown. In fact, this contradiction is not even acknowledged.

Thus, as seen by Appellant, the Examiner's Answer simply ignores the clear contradiction on the face of the Office Action, and does nothing to remedy this deficiency of the Office Action.

In view of the above, Appellant maintains that there is a clear deficiency in the prima facie case in support of the rejection.

2. The Rejection Of Claims 12 And 21 Should Be Reversed Because Appellant's Figure 17 Is Not Necessarily Prior Art.

Appellant maintains that a view for explaining a conventional technique does not necessarily mean that the explanation itself is conventional. In this regard, Appellant has repeatedly provided a credible explanation that Figure 17 was created by the Appellant in order to explain his own discoveries relative to problems in conventional techniques. Since Figure 17 contains Appellant's own discoveries, it is not correct to state that it illustrates "only that which is old". See MPEP § 2129. As such, it is error for the Examiner to insist that Figure 17 is "Applicant Admitted Prior Art". For a fuller discussion of these points, see Appeal Brief, pages 18 and 19.

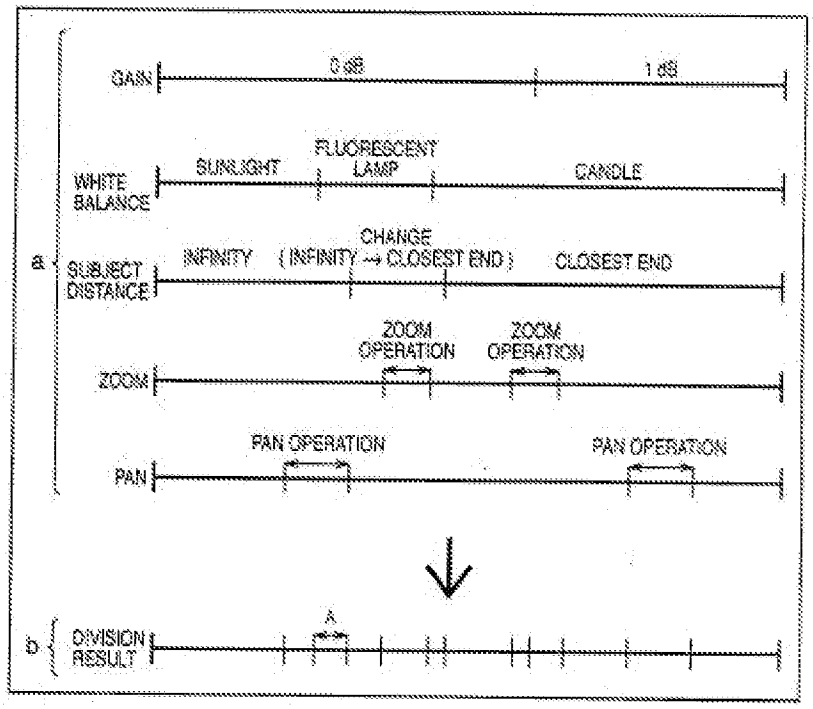
3. The Rejection Of Claims 12 And 21 Should Be Reversed Because Appellant's Figure 17 Can Not Possibly Show Hierarchization Of A Plurality Of Division Information, As Figure 17's Division Information Is Flat.

Even accepting the Examiner's incorrect characterization of Figure 17 as prior art solely for the purpose of argument, Appellant's Figure 17 shows division information that is flat. As such, since Figure 17's division information is flat, it cannot possibly show a hierarchization of a plurality of division information including an upper layer and a lower layer, much less hierarchizing a plurality of division information generated for each item group, and of adding division positions based on division information of an

upper layer to division positions of division information of a lower layer. As discussed below, the different camera operations of Figure 17(a) are depicted vertically on the page merely as a tool for the visual convenience of the reader: because of the vertical depiction, the reader is able to visually trace the changing points of each camera operation in Figure 17(a) down to the flat interval shown in Figure 17(b), which depicts the undesirable result that occurs because the camera operations of Figure 17 (a) are *not* in a hierarchy.

For convenience in the following discussion, Figure 17 is reproduced below:

FIG. 17



The Examiner's Answer states:

> "As shown in Fig. 17, since division positions based on a plurality of different items are present together, the moving image is segmented into many intervals. Since a hierarchy is defined as graded or ranked series (See Merriam Webster's Collegiate

Dictionary, Tenth Edition), and *Fig. 17 clearly discloses where the changing points are positioned in the ordered of Gain, White Balance, Subject distance, Zoom and Pan.* Therefore, Fig. 17 clearly discloses where position (hierarchy) of the changing points (division information) is in the order of the Gain, White Balance, Subject distance, Zoom, and Pan, which reads upon the claimed limitation." Examiner's Answer, page 16 (emphasis added).

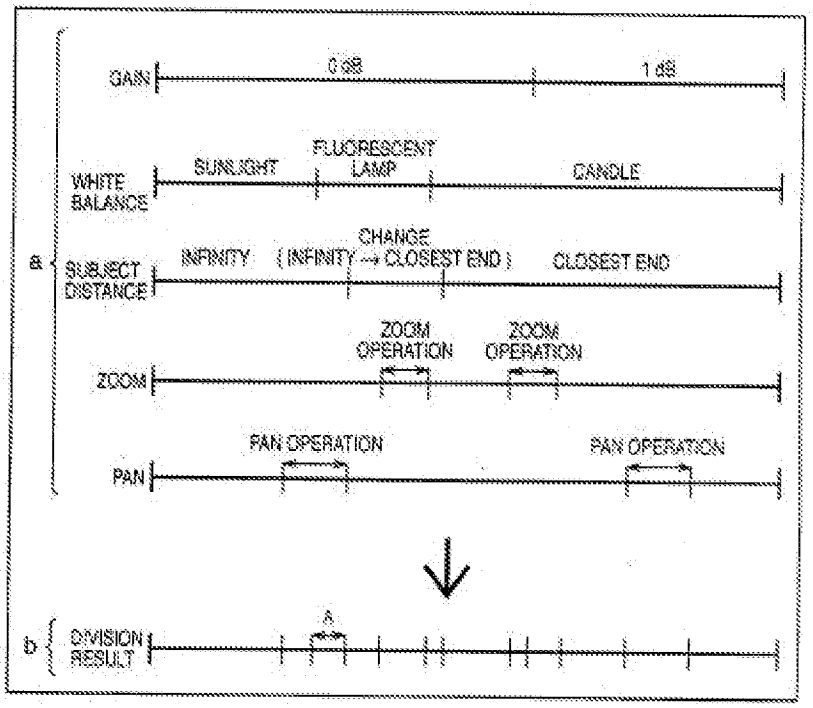
Thus, the Examiner's Answer seems to assert that that because examples of changing points for Gain, White Balance, Subject distance, Zoom and Pan are positioned visually one above the other on the physical page showing Figure 17(a), these changing points are somehow "ranked". The Examiner's Answer emphasizes this point at page 26:

> "[T]he changing points are ordered by the Gain, White Balance, Subject distance, Zoom, and Pan, the examiner interprets this order to be a hierarchy, where *the gain is higher [than] white balance, white balance, subject distance higher than zoom, and zoon [sic, zoom] higher than pan, which reads upon upper and lower layers*." Examiner's Answer, page 26 (emphasis added).

The Examiner's Answer continues to interpret Figure 17 contrary to its description in this application, and contrary to the interpretation that would be given by those of ordinary skill. To the Examiner, Figure 17 shows a hierarchy including an upper layer and a lower layer. But the entire purpose of Figure 17 is to show a lack of such hierarchy. This can be understood from page 2 of the instant application, which clearly states that division positions from the respective camera operations of Figure 17(a) are "present together" on the interval on Figure 17(b). Consequently, division points from one operation (e.g., White

balance) on the interval are "present together" with division points from another operation (e.g., Pan). The text from page 2 is reproduced below, along with Figure 17:

FIG. 17



"(a) of Fig. 17 shows the changing points (Gain, White Balance, subject distance, Zoom, Pan) of the operation intervals and the states of the image sensing device with respect to a single moving image for respective items. (b) of Fig. 17 shows the image dividing result using [Figure 17(a)'s] Gain, White Balance, subject distance, Zoom, and Pan items. As shown in (b) of Fig. 17, since *division positions based on a plurality of different items are present together*, the moving image is segmented into many intervals. Also, when a given interval is determined by a plurality of different items, it does not become a significant unit (note that the significant unit means, for example, an interval where subject A appears). For example, interval A in (b) of Fig. 17 starts from a changing point of White balance, and

ends at an end point of Pan operation, and does not form a significant unit." Specification, page 2 (emphasis added).

Figure 17(a) simply depicts respective division points for each of the different camera operations, and these division points are depicted vertically for visual convenience, so that the reader can trace the same flat division points for each camera operation to the flat interval shown in Figure 17(b). In fact, in the context of Figure 17, there is no relationship at all between the different camera operations of Figure 17(a), much less a hierarchy. Rather, the division points for each camera operation of Figure 17(a) are entered independently and without regard to the other camera operations on the result in Figure 17(b), leading to an undesirable result in which multiple insignificant divisions are created.

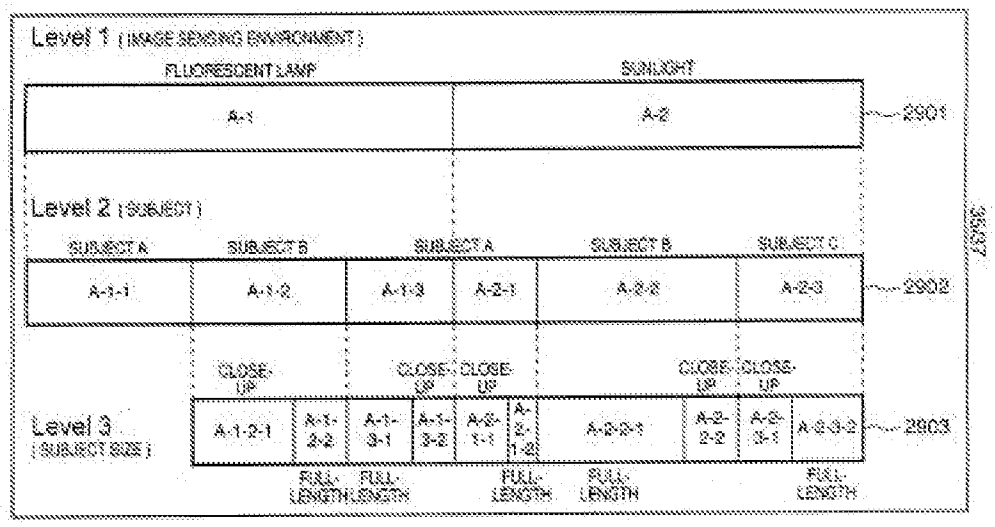
In that regard, Figure 17(a) should not be viewed divorced from its context in Figure 17 as a whole, and particularly with regard to Figure 17(b). Figure 17(a) is simply a tool in which the division positions for each camera operation are conveniently shown at once on the same page, along with the result in Figure 17(b) of separately entering the division positions for each camera operation of Figure 17(a) without regard to one another. Presumably, Appellant could have chosen to depict each of the camera operations of Figure 17(a) on a separate sheet or in a horizontal row, but this would clearly subtract from the visual convenience of Figure 17(a) as shown, in which the reader can trace the flat division points for each camera operation to the flat result shown in Figure 17(b).

Thus, as can be seen, the camera operations in Figure 17(a) are flat (i.e., on equal footing), and are simply shown vertically for the purpose of tracing those points to the flat interval of Figure 17(b). Particularly, because the camera operations Pan, Zoom, etc. are not ranked in any manner, the changing points for the different items are all "present

together" on the same flat interval of 17(b). Thus, because the division points are flat and are not arranged in a hierarchy of layers, division points from one camera operation (e.g., White balance) on the interval run into division points from another camera operation (e.g., Pan).

In contrast, Appellant's Figure 29 depicts an example of an embodiment according to the claims in which different camera operations are ranked in a hierarchy including plural layers such as an upper layer and a lower layer. Figure 29 is depicted below, along with examples of accompanying text in the specification and corresponding language regarding the hierarchization step of Claim 12:

FIG. 29



Specification	Claim 12
"Fig. 29 is a view for explaining an outline of sub shot hierarchization. In Fig. 29, 2901 to 2903 indicate the same moving image file as that	a hierarchization step of hierarchizing a plurality of division information generated for each item group, and of adding division positions based on

which has the sub shot division results 2601 to 2603 in Fig. 26. That is, Fig. 29 shows the hierarchization result on the basis of the respective sub shot division viewpoints in Fig. 26. Reference numeral 2901 denotes a first layer (level 1) which includes the division result from the viewpoint of image sensing environments. Reference numeral 2902 denotes a second layer (level 2) which includes the division result from the viewpoint of subjects. Note that how to determine the hierarchization relationship among layers will be described later. As lower layers of an interval (A 1) as an image sensing interval under the light of the fluorescent lamp, in the first layer 2901, an interval (A 1 1) as an image sensing interval of subject A, an interval (A 1 2) as an image sensing interval of subject B, and an interval (A 1 3) as another image sensing interval of subject A are present. Likewise, as lower layers of A 2, layers A 2 1, A 2 2, and A 2 3	division information of an upper layer to division positions of division information of a lower layer, wherein the plurality of division information is hierarchized and the division positions are added in a case that the plurality of division information is generated in the generation step in correspondence with a plurality of item groups.

are present. Reference numeral 2903 denotes a third layer (level 3) which includes the division result from the viewpoint of subject sizes. As lower layers of the interval (A 1 2) as the image sensing interval of subject B under the light of the fluorescent lamp, an interval (A 1 2 1) as a close up shot interval of subject B, and an interval (A 1 2 2) as a full length shot interval of subject B are present. Likewise, layers A 1 3 1 and A 1 3 2 are present as lower layers of A 1 3; layers A 2 1 1 and A 2 1 2 as lower layers of A 2 1; layers A 2 2 1 and A 2 2 2 as lower layers of A 2 2; and layers A 2 3 1 and A 2 3 2 as lower layers of A 2 3. …In this way, the user can search for a desired interval of a moving image by displaying sub shots in turn from upper layers. In the example of Fig. 29, the user can narrow down sub shots in turn for respective viewpoints like "under the light of the fluorescent lamp" (first layer), "subject	

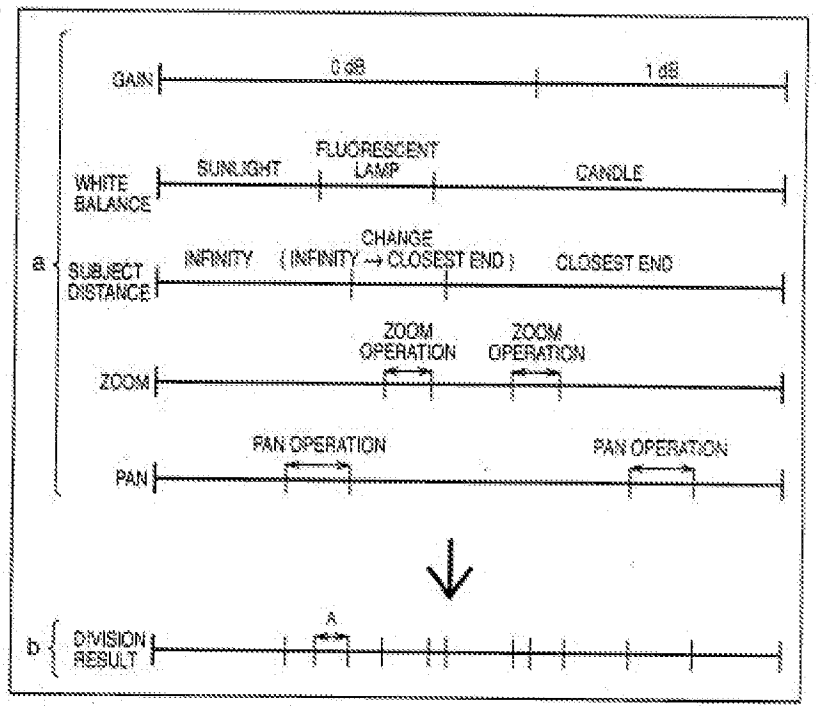
B" (second layer), and "close up" (third layer)." Specification, pages 65, 66 and 69.	

As can clearly be seen from Figure 29, the different operations are specifically ranked in plural layers including an upper layer and a lower layer(s) of division information for respective item groups – image sensing environment as the first layer, subject as the second layer, and subject size as the third layer. Thus, the user can browse when narrowing down sub-shots for respective viewpoints like "under the light of the fluorescent lamp" (first layer), "subject B" (second layer), and "close up" (third layer).

Drawings must be evaluated for what they reasonably disclose and suggest to one of ordinary skill in the art. See MPEP §2125, citing *In re Aslanian*, 590 F.2d 911, 200 USPQ 500 (CCPA 1979).

In that regard, Appellant submits that one of ordinarily skill in the art would clearly recognize that simply because an item is visually depicted above another item on a page does not mean that the items are in a ranking or hierarchy including an upper layer and a lower layer, any more than this line of text is somehow "ranked" below the one above it. Figure 17 is reproduced yet again below for convenience:

FIG. 17



With particular regard to Figure 17(a), one of ordinarily skill in the art would recognize that the visual positioning of the different camera operations on the physical page is for convenience in demonstrating the exact opposite of a ranking or hierarchy, e.g., that the camera operations of Figure 17(a) are "flat"; particularly, the different flat camera operations of Figure 17(a) are depicted vertically on the same page to make it easier for the reader to view in Figure 17(b) the disadvantage caused when these camera operations are *not* ranked. See Specification, page 2.

Put another way, Figure 17(a) shows flat respective changing points caused from different camera operations Gain, White Balance, Subject distance, Zoom and Pan in a vertical column so that the flat respective changing points from Gain, White Balance, Subject distance, Zoom and Pan can be traced down the physical paper to Figure 17(b) to show the disadvantage caused because the camera operations are *not* in a hierarchy including

plural layers of an upper layer and a lower layer, i.e., because each of the flat camera operations are treated the same on a flat interval, and without regard to each other, much less a hierarchy.

Figure 17(b), in turn, specifically depicts the problems caused when there is *not* hierarchization between the camera operations of Figure 17(a). Specifically, since there is no hierarchization between Gain, White Balance, Subject distance, Zoom and Pan as shown in Figure 17(a) and the respective changing points are entered into the flat division result of 17(b) with the same importance, the resultant moving image ends up being segmented into too many intervals, many of which are insignificant intervals.

It is possible that the Examiner is viewing Figure 17 in a vacuum, divorced from its textual description. This would be legal error, and it would be contrary to the view of those of ordinary skill. Put another way, it is error to interpret the drawings contrary to the view of one of ordinary skill in the art, and in making that determination, one of ordinary skill in the art would look not only to the drawing itself, but also to its corresponding description in the specification. See, e.g., *Nystrom v. TREX Co.*, 76 USPQ2d 1481, 1491 (Fed. Cir. 2005) ("Under the principles set forth in our prior cases, the speculative modeling premised on unstated assumptions in prior art patent drawings cannot be the basis for challenging the validity of claims reciting specific dimensions not disclosed directly in such prior art."); *Ex parte Frye*, BPAI Appeal 2009-006013 (February 26, 2010), *Ex parte Pham,* BPAI Appeal 2009-005134 (October 14, 2009); see also *Vas-Cath Inc. v. Mahurkar,* 935 F. 2d 1555, 1566 (Fed. Cir. 1991) ("Consideration of what the drawings conveyed to persons of ordinary skill is essential.").

In her Answer, the Examiner states that she is equating hierarchy with position, and it is perhaps possible that the Examiner is referring to horizontal positions of Figure 17(b) rather than vertical positions of Figure 17(a). See Answer, pages 14-15: "The Examiner notes that a hierarchy is synonymous with positions. ... As shown in Figure 17, since division positions based on a plurality of different items are present together, the moving image is segmented into many intervals, it is clear to the Examiner that AAPA discloses the positions (hierarchy) for a plurality of division information ... which reads upon the claimed limitation."

If this view of the Examiner's rejection is correct, then it seems that the Examiner is somehow visually rotating Figure 17(b) 90°, and interpreting the flat division points of Figure 17(b) as a hierarchy because, after rotation by 90°, the division points would be in a vertical column.

It is not understood how division positions "present together" on a flat interval can possibly be "synonymous" with a hierarchy including an upper layer and a lower layer, as stated by the Examiner. Appellant respectfully submits that the assertion "a hierarchy is synonymous with positions" is simply incorrect given the language of the claims. This point is particularly evident in this case, where each of the division points for the respective operation information in Figure 17(a) are flat, and where the same division points are present together on an interval shown in Figure 17(b) which is also flat.

To the extent that the Examiner is somehow rotating Figure 17(b) by 90° so that the division points would be in a vertical column, Appellant submits that such interpretation is at odds with Figure 17 itself, the specification, and the understanding of Figure 17(b) by one of ordinary skill in the art.

It is wrong for the Examiner to treat Figure 17 as her own private Rorschach test, and explain what she sees in Figure 17, as opposed to what is actually depicted there. Page 2 of the specification, quoted above, is unequivocal in its description of the actual content of Figure 17:

> "(a) of Fig. 17 shows the changing points (Gain, White Balance, subject distance, Zoom, Pan) of the operation intervals and the states of the image sensing device with respect to a single moving image for respective items. (b) of Fig. 17 shows the image dividing result using [Figure 17(a)'s] Gain, White Balance, subject distance, Zoom, and Pan items. As shown in (b) of Fig. 17, since *division positions based on a plurality of different items are present together*, the moving image is segmented into many intervals. Also, when a given interval is determined by a plurality of different items, it does not become a significant unit (note that the significant unit means, for example, an interval where subject A appears). For example, interval A in (b) of Fig. 17 starts from a changing point of White balance, and ends at an end point of Pan operation, and does not form a significant unit." Specification, page 2 (emphasis added).

As discussed above, in the context of Figure 17 there is no relationship at all between the camera operations of Figure 17(a); rather, the division points for each camera operation are entered independently and without regard to the other camera operations, which yields the result in Figure 17(b). Figure 17(a) is simply a tool to conveniently show the division positions for each camera operation at once on the same page, along with the result in Figure 17(b) of separately entering the division positions for each camera operation without a hierarchy including an upper layer and a lower layer.

Contrary interpretations of Figure 17, as somehow showing a hierarchy including plural layers, e.g., an upper layer and a lower layer, are exactly that: contrary to the interpretation that would be given by those of ordinary skill. Those contrary interpretations are also incorrect as a matter of technology, and as a matter of law. Figure 17 unquestionably shows a flat timeline with no hint of the hierarchy of division information of item groups into upper and lower layers that characterizes the rejected claims. It is wrong as a matter of law to interpret Figure 17 contrary to the interpretation that would have been given by those of ordinary skill, and those of ordinary skill would interpret Figure 17 not only by reference to the depiction of Figure 17 itself, but also by reference to the textual description of Figure 17 in the specification.

Thus, Appellant respectfully submits that one of ordinary skill in the art would recognize there is absolutely no ranking or hierarchy between the camera operations for Gain, White Balance, Subject distance, Zoom and Pan shown in Figure 17(a), and in fact, the combination of Figure 17(a) and Figure 17(b) is specifically provided to show precisely the disadvantages that result from the lack of a hierarchy between the camera operations shown in Figure 17(a).

Accordingly, Appellant reiterates that Figure 17 fails to disclose or suggest hierarchizing a plurality of division information generated for each item group of a plurality of item groups, much less hierarchizing a plurality of division information generated for each item group, and of adding division positions based on division information of an upper layer to division positions of division information of a lower layer. Therefore, Appellant maintains that the rejection of Claims 12 and 21 should be reversed.

4. The Rejection Of Claims 12 And 21 Should Be Reversed Because the Office Action Provides Inadequate Rationale To Combine Matsushita '488 And AAPA.

As submitted in the Appeal Brief, the Office Action's provides one conclusory statement as to why one of ordinary skill in the art at the time of the invention would combine Matsushita '488 and AAPA, namely "for providing more efficient image processing":

> "Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teaching of AAPA with Matsushita for providing more efficient image processing." Office Action, page 9; See also Office Action, pages 10 and 14.

The Examiner's Answer does not defend or otherwise address the original rationale put forth in the Office Action. Rather, at pages 21 to 22, the Answer provides an entirely new rationale:

> "...Matsushita '488 is concerned with creating a video digest generation method, [0001] and discloses where conventionally, as a means to grasp the contents of video for a short time, by fast forward reproduction of VTR, thinned out the frame equally, and it was displayed, and there was a method of adjusting display speed manually using good gear change reproduction of a jog shuttle dial etc, [0002]. Further, although, the picture could be displayed in good gear change reproduction at the speed which was adapted for the users interest and degree of comprehension, there was a problem that all the video covering a long time also had to be operated manually, [0004]. AAPA discloses where since a moving image is divided in correspondence with the changing points of operation (pan, tilt) or

states (focus and the like) of a moving image sensing device, a playback process from a desired location, a moving image edit process, and an automatic generation of a summary of a moving image can be achieved, thus allowing easy confirmation of the contents. Such method is effective especially when one moving image contains various subjects to be sensed or when an image sensing environment changes, see paragraph [0002]. Since, Matsushita '488 is concerned with creating a digest of video content and for short and long video to manually adjust the display speed, and AAPA discloses that for video image divided with the changing points or states, a playback process from a desired location, a moving image edit process, and an automatic generation of a summary of a moving image can be achieved, thus allowing easy confirmation of the contents. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Matsushita with AAPA for providing a playback process from a desired location, a moving image edit process, automatic generation of a summary of a moving image that allows easy confirmation of the contents, which would improve image processing. Further, the examiner notes that KSR does not require that the rational [sic, rationale] necessarily comes from the art itself. However, in this case, the rationale can be found in AAPA." Examiner's Answer, pages 21 and 22; see also similar rationale at pages 23 and 24.

Appellant respectfully submits that this rationale was never provided in the Office Action. As seen by Appellant, this new rationale can not post-hoc justify the deficient rationale originally provided in the Office Action. Moreover, in Appellant's view, the above rationale does not elaborate on the original rationale ("for providing more efficient image processing"); indeed, the above new rationale does not mention efficiency at all.

In Appellant's view, it is unfair to require applicants to go through the expense of filing a full Appeal Brief to obtain a more thorough rationale, as opposed to a mere conclusory statement (such as that originally provided in the Office Action). This point is especially relevant when, as here, the new rationale provided in the Examiner's Answer also appears to be quite different from the original. Similar concerns have been raised recently in regards to proposed new guidelines for Appeal Briefs and Reply Briefs, and particularly those addressing new grounds of rejection in an Examiner's Answer. See, e.g., Federal Register, Vol. 75, No. 219, page 69838 ("A 'position or rationale new to the proceedings' – even if based on evidence previously of record - may give rise to a new ground of rejection.", citing *In re De Blauwe*, 736 F.2d. 699, 706 n.9.).

At any rate, the new rationale provided in the Examiner's Answer is also seen to be deficient. In particular, Appellant submits that none of the background paragraphs cited in the Examiner's Answer for Mastushita '488 and AAPA suggest the need for the another reference, as these paragraphs are directed to problems solved by the respective reference itself. Specifically, Matsushita '488 is directed to creating a digest to solve problems in manually adjusting a display of a moving image (e.g., by using a jog dial to fast forward), whereas the AAPA is directed to problems caused when a moving image is divided by too many changing points. There is no suggestion in Matsushita '488 of a problem of too many changing points; conversely, there is no suggestion in AAPA of any problems raised by manually adjusting a display of an image using a jog dial.

Moreover, in view of the incompatibility between Matsushita '488 and AAPA, one of ordinary skill in the art would not be motivated to combine these references. Specifically, the concept of Matsushita '488 is very different from the claimed feature of

hierarchizing a plurality of division information generated for each item group, and of adding division positions based on division information of an upper layer to division positions of division information of a lower layer, wherein the plurality of division information is hierarchized and the division positions are added in a case that the plurality of division information is generated in the generation step in correspondence with a plurality of item groups. The Examiner concedes as much in the final rejection:

> "Matsushita ['488] does not explicitly teach hierarchization step of adding division positions based on integrated division information of an upper layer to division positions of integrated division information of a lower layer in accordance with a hierarchization order of a plurality of pieces of integrated division information, which are generated in the generation step in correspondence with a plurality of item groups." Final Office Action dated September 14, 2009, page 8.

Accordingly, given the significant differences between Matsushita '488 and AAPA, Appellant submits that one of ordinary skill in the art would not be motivated to combine these references.

For at least the reasons above, Appellant submits that the new rationale provided in the Examiner's Answer cannot cure the deficiencies of the rationale provided in the original Office Action.

B. Dependent Claim 13

1. The Rejection Of Claim 13 Should Be Reversed Because Key Features Of The Claim Are Not Disclosed Or Suggested By The Applied Art.

Since independent Claim 12 is believed to be allowable for the reasons above, it logically follows that Claim 13, which is dependent therefrom, should be allowable for at least the same reasons. In view of these reasons, Appellant resubmits that the applied art fails to disclose or suggest the even further features defined in Claim 13.

In that regard, the Examiner's Answer essentially argues that the additional subject matter of Claim 13 would be obvious based on the arguments for independent Claims 12 and 21.

For purposes of conciseness, Appellant will not reiterate the above arguments with respect to independent Claims 12 and 21, but submits that in view of the deficiencies of the rejection of Claim 12, Claim 13 should be allowed for at least those reasons alone.

Nevertheless, Appellant further submits that the Examiner's Answer does not appear to point to any additional sections of the art which would disclose the additional features presented in Claim 13. In fact, the Examiner's Answer is seen merely to rely on the same rationale advanced for independent Claim 12, and is not seen to provide any rationale in addition to that of independent Claim 12 as to why it would have been obvious to one of ordinary skill in the art to count a number of divisions for each type of division information, much less to use such a count to set a hierarchical order of the plurality of pieces of division information, as claimed.

In a rejection under Section 103, all the claim limitations must be shown in as complete detail as is contained in the claim. See MPEP § 2143.03. When the reference is silent about an asserted inherent characteristic, extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be recognized by persons of ordinary skill. See MPEP § 2144.02. The rationale also may be based on common knowledge in the art or "well known" prior art. However, if the applicant traverses such an assertion, the Examiner should cite a reference in support of his or her position. See MPEP § 2144.03.

Here, the Examiner's Answer does not provide any of the above, and merely relies on same rationale advanced for Claim 12.

Appellant submits that such a position is insufficient to explain where the features of Claim 13 are possibly disclosed or suggested in the art. Thus, Appellant submits that the Examiner's Answer is not seen to remedy the deficient rejection of Claim 13.

Accordingly, Appellant submits that the applied art fails to disclose or suggest setting a hierarchical order of the plurality of pieces of division information on the basis of division counts of division information. Therefore, Appellant maintains that the rejection of Claim 13 should be reversed.

CONCLUSION

In view of the above, Appellant submits that the Examiner's Answer does not remedy the shortcomings of the final rejections, and that the rejections should be reversed.

Appellant's undersigned attorney may be reached in our Costa Mesa, California office at (714) 540-8700. All correspondence should continue to be directed to our below-listed address.

Respectfully submitted,

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